



PATENT

Docket No. 13065

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#8
Plunkett
1-24-00

Applicants: Boyce-Jacino et al.

Serial No.: 09/097,791

Examiner: Marschel, A.

Filed: June 16, 1998

Group Art Unit: 1655

Title: POLYMERASE SIGNALING
ASSAY

Kalow Springut & Bressler LLP
488 Madison Avenue
New York, New York 10022

January 7, 2000

Assistant Commissioner for Patents
Washington D.C. 20231

ELECTION / RESTRICTION

This is in response to the communication from the U.S. Patent and Trademark Office dated July 7, 1999 issued in connection with the above-identified patent application. In accordance with the Office Action and the attached request for a five-month extension of time, a response is due on January 7, 2000 and therefore this communication is timely filed.

Certificate of Mailing Under 37 C.F.R. 1.8

I hereby declare that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

7 January 2000
Date

Nathaniel Browand
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In the July 7, 1999 Office Action, the Examiner alleged that the subject invention is directed to a plurality of inventions and required restriction under 35 U.S.C. § 121 dividing the invention into two groups: Group I, claims 1-28; and Group II, claims 29 and 30. Specifically, the Examiner stated that claims 1-28 are drawn to methods analyzing a sequence and claims 29 and 30 are drawn to a sequence array.

Under MPEP 803, the criteria for a proper restriction requirement are: (1) the inventions must be independent or distinct as claimed; AND (2) there must be a serious burden on the Examiner if restriction is not required. Applicants maintain that it would not be a serious burden upon the Examiner if restriction is not required. Also, in view of the importance from the standpoint of public interest that no requirements be made which might result in the issuance of two patents for the same invention, as set forth in MPEP 803.01, applicants request that the restriction requirement be lifted.

Since a response to this restriction requirement must include an election of the invention to be examined, even though the requirement may be traversed, applicants hereby elect, with traverse, to prosecute the claims, drawn to methods for analyzing a sequence, corresponding to the putative independent invention of Group I.

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If a telephone conference would be of assistance in furthering the prosecution of the above-identified patent application, applicants' undersigned attorney requests that he be telephoned at the number provided.

No fee, other than the enclosed check for the five (5) month extension fee, is required in connection with the filing of this Communication. If any fee is deemed necessary, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 11-0171.

Respectfully Submitted,



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